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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,540	07/02/2003	Randy D. Baxter	RSW920030049US2	3593

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MARCIA L. DOUBET LAW FIRM
PO BOX 422859
KISSIMMEE, FL 34742

EXAMINER

KARDOS, NEIL R

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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04/16/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

Office Action Summary	Application No. 10/612,540	Applicant(s) BAXTER ET AL.	
	Examiner Neil R. Kardos	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-21 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-21 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/2/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a **NON-FINAL** Office Action on the merits in response to communications filed on March 17, 2009. Currently, claims 1, 3, 5-21, and 24-27 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3, 5-21, and 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied

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to a particular machine, or (2) transform a particular article to a different state or thing. *See in re Bilski*, 545 F.3d 943, 956 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform an article to a different state. Although the claim recites "programmatically computing" and "programmatically generating," this recitation does not necessarily involve a machine, let alone a particular machine. Programmatic is defined as "of, having, advocating, resembling, or following a plan, policy, or program." (Random House Dictionary, 2009). A human could compute an assessment score according to a plan. Furthermore, a software program could carry out the computation. Neither of these are sufficient to tie the claimed process to a particular machine. Thus, the claim process is unpatentable under § 101.

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Claim 14: Claim 14 is substantially similar to claim 1 and is rejected under similar rationale.

Claim 24: Claim 24 is substantially similar to claim 1 and is rejected under similar rationale.

Claim 26: Claim 26 recites functional descriptive material (i.e. a computer program) that does not impart functionality when employed as a computer component because the functional descriptive material is not tangibly embodied on a computer-readable medium. *See* MPEP 2106.01(I). The claim executable instructions is software per se, which is not patentable under § 101.

Claims 3, 5-13, 15-21, and 25: Dependent claims 3, 5-13, 15-21, and 25 are rejected for failing to remedy the deficiencies of the claims from which they depend.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 7-17, 21, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano (US 2002/0184082).

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Claim 1: Nakano discloses a method of assessing products for their target market, comprising:

- determining a plurality of criteria that are important to a target market, and at least one attribute to be used for measuring each of the criteria (see ¶ 26, disclosing converting customer requirements [e.g. criteria] into product characteristics [e.g. attributes]; ¶ 27, disclosing associating customer requirements with product characteristics; figure 2B; figure 4B; figure 9; ¶ 34, disclosing converting customer requirements into product characteristics as a technical matter of the product);
- specifying objective measurements for each of the attributes (see ¶ 42, disclosing measuring the value of the product characteristics; ¶ 43, disclosing determining product specifications of the product characteristics; figure 9, depicting measurable targets for the product characteristics);
- conducting an evaluation of the product, further comprising:
 - inspecting a representation of the product, with reference to selected ones of the attributes (see figures 4A-4D, depicting an evaluation of a family car; figures 9-10, depicting the results of an evaluation of a family car; ¶¶ 52, 59, and 63);
 - assigning attribute values to the selected attributes, according to how the product compares to the specified objective measurements (see figure 9, depicting values for the product characteristics; ¶ 42, disclosing a comparison analysis value, which is the measured value of the product

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characteristics; ¶¶ 43-45, disclosing outputting the estimated value of customer satisfaction for an actual achievement value of product characteristics; ¶¶ 49-50);

- programmatically computing a product assessment score, for the product, from the assigned attribute values (see figure 10, depicting a "customer attitude rating," which is the sum of the customer satisfaction scores for each customer requirement based on the score achieved by the product characteristics; ¶ 49);
- for each of the selected attributes for which the assigned attribute value falls below a threshold value, programmatically computing a product assessment score increase that will result by raising that assigned attribute value to the threshold value, the programmatically computing a product assessment score increase comprising recomputing the product assessment score for the product using the threshold value as a replacement for the assigned attribute value of the selected attribute (see figures 5-7, especially figure 5, depicting the present customer satisfaction when the product characteristic has the baseline value, and the value of customer satisfaction if the product characteristic is raised to the target value; ¶¶ 48-68, describing figures 5-7);

Nakano does not explicitly disclose programmatically generating a list of recommended actions, the list having an entry for each of the selected attributes for which the assigned attribute value falls below the threshold value, each of the entries providing at least one suggestion for

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improving the assigned attribute value and a specification of the programmatically-computed product assessment score increase for that selected attribute. However, Nakano at least suggests this limitation. Nakano teaches determining the impact that an improvement of a product characteristic will have on a customer satisfaction score (see e.g. ¶¶ 48-68). Nakano implicitly teaches recommendations for product characteristics by teaching a target value for the characteristics (i.e. the recommendation is to build the product so that the product characteristic meets the target value; see figure 9).

Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to perform the claimed limitation via a gap analysis. Gap analysis is a well-known technique to compare actual performance with desired performance and to determine how to achieve the desired performance, and is commonly performed in new product development. It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the claimed limitation via gap analysis in order to achieve the target product characteristic values taught by Nakano. One of ordinary skill in the art would have been motivated to do so for the benefit of improved customer satisfaction.

Nakano does not explicitly disclose performing the disclosed methodology for IT products. However, this is merely an intended use of the claimed limitation, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Nakano's methodology to evaluate IT products. One of ordinary skill in the art would have been motivated to do so for the benefits associated with utilizing Nakano's methodology in new product development (e.g. improved customer satisfaction).

Claim 3: Nakano discloses:

- prioritizing each of the attributes in view of its importance to the target market (see figure 2B, depicting customer importance ratings; figure 2D, depicting weights; figure 3; ¶ 76), ;
- assigning weights to the attributes according to the prioritizations (see id.); and
- using the weights when programmatically computing the product assessment score (see id.).

Claim 7: Nakano at least suggests wherein a product team developing the product provides input for the evaluation by answering questions on a questionnaire that reflects the attributes (see ¶ 6, disclosing QFD executors that are people engaged in product planning and provide input for product development; ¶ 23).

Claims 8-10: Nakano does not explicitly disclose recording information about scores, recommendations, and answers to questionnaires in a workbook, including an electronic workbook. Examiner takes Official Notice that it was well-known in the research and development arts at the time the invention was made to record research and development data in a workbook, including an electronic workbook (e.g. Microsoft Excel). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record the information gathered during the product development stages of Nakano in an electronic workbook according to well-known methods. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by recording data.

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Claims 11-12: Nakano discloses providing the scores and recommendations to a product team developing the IT product (see at least ¶ 6). Nakano does not explicitly disclose an assessment workbook. However, this deficiency has been addressed in the rejection of claims 8-10, above.

Claim 13: Nakano does not explicitly disclose assigning a special designation to the product if and only if the assessment score exceeds a predefined minimum product assessment score. However, this practice is old and well-known. For example, Consumer Reports designates products receiving a certain score as a "Consumer Reports Best Buy." Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply old and well-known assessment designations to the products assessed by the methodology of Nakano. This combination of known elements produces a result that would be predictable to one of ordinary skill in the art.

Claims 14-17: Claims 14-17 are substantially similar to claim 1 and are rejected under similar rationale.

Claim 21: Claim 21 is substantially similar to claim 13, and is rejected under similar rationale.

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Claim 24: Claim 24 is substantially similar to claim 1, and is rejected under similar rationale.

Claim 25: Nakano does not explicitly disclose charging a fee for carrying out one or more of the conducting, recording, and using steps. However, it is old and well-known to charge fees for conducting services in order to make a profit. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to charge a fee for carrying out the methodology of Nakano. One of ordinary skill in the art would have been motivated to do so for the benefit of profit.

Claims 26 and 27: Claims 26 and 27 are substantially similar to claim 1 and are rejected under similar rationale.

Claims 5, 6, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano in view of Korisch (US 2004/0068456).

Claim 5: Nakano does not explicitly disclose wherein conducting an evaluation is repeated at a plurality of plan checkpoints used in developing the IT component. Korisch teaches repeatedly checking to determine if a product meets predetermined specifications in order for that product to proceed to the next step (see figure 4, item 29; paragraph 154, lines 19-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to repeat the methodology of Nakano throughout the design process as taught by Korisch.

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One of ordinary skill in the art would have been motivated to do so for the efficiencies gained by meeting product requirements (see Korisch, paragraph 154, lines 22-24).

Claim 6: Nakano does not explicitly disclose wherein successful completion of each of the plan checkpoints requires the product assessment score to exceed a predetermined minimum product assessment score . Korisch teaches repeatedly checking to determine if a product meets predetermined specifications in order for that product to proceed to the next step (see figure 4, item 29; paragraph 154, lines 19-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to repeat the methodology of Nakano throughout the design process as taught by Korisch. One of ordinary skill in the art would have been motivated to do so for the efficiencies gained by meeting product requirements (see Korisch, paragraph 154, lines 22-24).

Claim 20: Claim 20 is substantially similar to claim 6, and is rejected under similar rationale.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano in view of Lowe, “QFD in new production technology evaluation.”

Claims 18-19: Nakano does not explicitly disclose wherein the specified objective measurements further comprise textual descriptions to be used in the step of assigning attribute values using a multi-point scale. Lowe discloses these limitations (see col. 1-2 on page 108, disclosing guidelines for establishing scoring values based on a four-point scale; table 1,

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disclosing definitions for product characteristic levels; table 2, disclosing guidelines for evaluation of interrelationship values; table 3, disclosing guidelines for importance scoring). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the guidelines disclosed by Lowe to score the attributes of Nakano.. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies and accuracies gained through standardization.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Neil R. Kardos
Examiner
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NRK
4/11/09
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623